

REMARKS

An interview by telephone was held on December 9, 2003 between Examiner Phan and Applicants' representative, LeRoy Maunu. The limitations of claim 1 were discussed, and no agreement was reached as to patentability.

As explained in the interview, the most recent Office Action brings the application no closer to a final disposition than did the first Office Action. The present application has been the subject of two Office Actions followed by an Appeal Brief, reopening of prosecution in a third Office Action, and presently a fourth, non-final Office Action. In the interests of expediting prosecution, Applicants respectfully request that the substance of the next Action be sufficient to either move the case forward to Allowance or to satisfy the legal requirements of a rejection.

The Office Action fails to establish that claims 1-20 are unpatentable under 35 USC §103(a) over US patent number 6,120,549 to Goslin et al. ("Goslin") in view of US patent number 6,554,531 to Kim et al. ("Kim"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are taught by the references, fails to provide a proper motivation to combine the references, and fails to show that Goslin could be successfully modified with the teachings of Kim with reasonable success. Thus, the Office Action fails to establish a *prima facie* case of obviousness.

It is respectfully submitted that Goslin may not be considered to preclude patentability. Goslin qualifies as prior art under 35 USC §102(e). However, the accompanying documents evidence that both Goslin and the present application were assigned/subject to assignment to Xilinx, Inc., at the time the present invention was made. These documents include assignment forms for the application that later issued as U.S. Patent No. 6,120,549 (Goslin) and for the present application.

Therefore, under 35 USC §103(c) Goslin may not be considered to preclude patentability. It is further noted that,

even though Goslin may not be considered, the cited teachings of Goslin fail to address the limitations of the independent claims that relate to simulating circuit behavior.

Further, the cited teachings of Kim do not suggest the claim limitations. Various passages from Kim clearly explain that Kim suggests randomly generating stimuli during simulation, not the claim limitations that relate to randomly generating a set of parameter values for a logic core and generating a netlist from the set of parameter values and the logic core. For example, Kim's title calls out random stimulus generation. Furthermore, Kim teaches:

The Verilog simulator executes a Verilog language model of a hardware device under test, while the Vera simulator executes a Vera language model of the environment in which the DUT is to be tested. As an environment simulator, the basic functionality of the Vera simulator is to simulate the DUT by driving certain of its inputs and to monitor the resulting states of the DUT by sampling the values of its nodes. (col. 6, ll. 48-55)

Furthermore, Kim's invention adds to Vera capabilities that facilitate the generation of random data (col. 10, ll. 30-32). Thus, Kim's teachings are not suggestive of the present claims.

The rejections of the remaining claims rely either on teachings of Goslin, which may not be used to preclude patentability, or on Kim, which is not applicable as explained above. Therefore, the rejections fail to show that the limitations of these claims are suggested by the prior art.

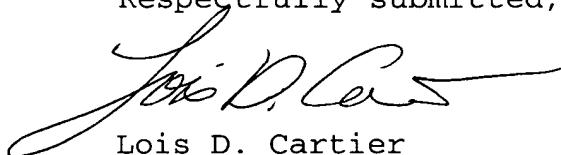
Because the Office Action alleges a motivation for modifying Goslin with Kim, and Goslin may not be used to preclude patentability, the alleged motivation is moot and insufficient to support *prima facie* obviousness. Similarly, the issue modifying Goslin with Kim with reasonable success is moot.

For at least the reasons set forth above, the Office Action fails to establish a *prima facie* case of obviousness of any of claims 1-20.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 16, 2003.

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